

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-32 are pending in the application. Claim 1 has been amended. No new matter has been introduced.

Independent claim 1 has been amended to include language similar to the language of independent claim 15. Accordingly, Assignee respectfully requests that the amendment be entered after final. Additionally, the above amendment was made to clarify Assignee's claim 1 and does not narrow the scope of the amended claim. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendment.

Claim Rejections – 35 U.S.C. §102:

Claims 1, 3-6 and 15-32 were rejected under 35 U.S.C. §102(b) as being anticipated by Fujioka et al., (U.S. Patent No. 5,414,481) (hereinafter "Fujioka").

It is noted that the Examiner can establish anticipation only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131.01. It is asserted that the Examiner has not established that Fujioka meets this requirement.

Assignee respectfully submits that Fujioka does not disclose all of the elements of independent claim 15. For example, Examiner has not established that Fujioka discloses *"focusing an image of a first object through a transparent window of an optical*

scanner, wherein the first object is positioned remote from said optical scanner; and scanning the image focused through the transparent window to obtain an image of the first object.” Assignee previously traversed the Examiner’s assertion that “[i]t is common for an overhead projector such as Fujioka to be used to project (or in the reverse image) either a blackboard or white board.” See page 3 of the Office Action. Assignee continues to traverse the Examiner’s assertion of common knowledge and contends that the Examiner has not established that the noticed fact is considered to be common knowledge or well-known in the art. Specifically, the Examiner contends that in Fujioka “the optics of the projector are capable of passing an image of a projection screen down to the scanner (5) (See for example JP 06-148744 to Sakai which in figure 3 shows passing an image off of a screen through optics down to a sensor (14)”. See page 3 of the Office Action. The Examiner contends that the “Sakai reference has been added to show that it is inherent that the projection optics of an overhead projector can in fact image the projection surface.” See page 12 of the Office Action. Assignee cannot agree. Specifically, the Examiner has not pointed to any portion of Sakai supporting the assertion that an “image” is passed to item 14 of Sakai. Conversely, the Abstract of Sakai indicates that Sakai is directed to “remote controls”, presumably such as “indicator 18” to be “detected by an optical sensor 14” to execute “drive controls”. See the Abstract of Sakai. Accordingly, Assignee invites the Examiner to provide a reference supporting the Examiner’s contention or an affidavit establishing facts known by the Examiner supporting the Examiner’s contention that it is common knowledge to one of ordinary skill in the art that projectors such as Fujioka be used to image vertical objects such as blackboard or whiteboard. In the absence of such evidentiary showing by the Examiner,

Assignee respectfully requests that the Examiner withdraw the rejection of claim 15, consistent with the requirements of MPEP § 2144.03.

Likewise, claims 1, 3-6, and 16-32 distinguish from Fujioka on at least the same or similar basis as claim 15. Therefore, Assignee respectfully requests that Examiner's rejection of claims 1, 3-6, and 16-32 be withdrawn.

Claim Rejections – 35 U.S.C. §103:

Claims 2 and 7-14 were rejected under 35 USC § 103 as being unpatentable over Fujioka in view of various additional art. Specifically, claim 2 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. as applied to claims 1, 3-6 and 15-32 above, and further in view of Minnesota Mining and Manufacturing Company (3M), (EP 0 550 038); claims 7-8 and 11-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. in view of Konno et al. (US Patent 5,325,137); claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. in view of Konno et al. as applied to claims 7-8 and 11-14 above, and further in view of Stocker (US Patent 2004/0095614); and claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka in view of Konno as applied to claims 7-8 and 11-14 above, and further in view of Minnesota Mining and Manufacturing Company (3M), (EP 0 550 038).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

In response, Assignee respectfully submits that claims 2 and 7-14 are not obvious, at least on the same or similar basis as claim 1 as set forth above with respect to the anticipation rejection in view of Fujioka. Specifically, the Examiner has failed to establish that Fujioka teaches or suggests *"a scanning module, disposed within the scanning body and capable of reciprocally moving underneath the transparent window and capable of horizontally receiving an image of the generally vertical object, the scanning module comprising: a shell, comprising a light cone opening capable of receiving an imaging light of the generally vertical object"*, as recited in independent claim 1. Additionally, Assignee respectfully submits that the Examiner has failed to establish that the proposed combinations cure Fujioka of this failure. In the absence of the Examiner pointing to such a disclosure in the proposed combinations, Assignee respectfully requests that the rejection be withdrawn on the basis that the Examiner has failed to establish that the proposed combinations teach or disclose all the claim limitations.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

In the event an extension of time is required, please consider this a request there for, and charge the extension or any other additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the attorney of record, James J. Lynch, at (503)439-6500 if there remains any issue with allowance.

Respectfully submitted,
ATTORNEY FOR ASSIGNEE

Date: _____

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